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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/887,680	10/26/2001	Richard N. Terry	02706-0421 (42276-265479)	3031

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EXAMINER

ROBERTSON, JEFFREY

ART UNIT

PAPER NUMBER

1712

DATE MAILED: 01/16/2003

4

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/887,680

Applicant(s)

TERRY ET AL.

Examiner

Jeffrey B. Robertson

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 26 October 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-58 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-3, 5-45, 52-55, and 58 is/are rejected.
- 7) ☒ Claim(s) 4, 49-51 and 56 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

Double Patenting

1. A rejection based on double patenting of the "same invention" type finds its support in the language of 35 U.S.C. 101 which states that "whoever invents or discovers any new and useful process ... may obtain a patent therefor ..." (Emphasis added). Thus, the term "same invention," in this context, means an invention drawn to identical subject matter. See *Miller v. Eagle Mfg. Co.*, 151 U.S. 186 (1894); *In re Ockert*, 245 F.2d 467, 114 USPQ 330 (CCPA 1957); and *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970).

A statutory type (35 U.S.C. 101) double patenting rejection can be overcome by canceling or amending the conflicting claims so they are no longer coextensive in scope. The filing of a terminal disclaimer cannot overcome a double patenting rejection based upon 35 U.S.C. 101.

2. Claims 5-8, 14-19, 46, and 47 are rejected under 35 U.S.C. 101 as claiming the same invention as that of claims 46 and 47 of prior U.S. Patent No. 6,329,488. This is a double patenting rejection.

Claim 46 of the instant application and claim 46 of '488 are identical. For claims 19 and 47 of the instant application, there is a slight difference in wording in relation to Carbowax 1450 in the instant application and "polyethylene glycol having a molecular weight of approximately 1450" in claims 19 and 47 of the '488 patent. These materials are the same.

Claim 5 of the instant application and claim 5 of the '488 patent differ only in the use of the word "lubricious" before "polymers having at least two functional groups" in the instant application and the process steps that produce the silane copolymer are numbered. As indicated in column 3, lines 56-57, and column 4, lines 54-55 of the specification of the '488 patent, the polymers having two functional groups are lubricious.

Claim 7 of the instant application and claim 7 of the '488 patent differ in that claim 7 of the '488 patent merely identifies what reaction the catalyst catalyzes.

Claims 6, 8, and 14-18, of the instant application are identical to claims 6, 60, and 14-18 of the '488 patent, respectively.

3. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

4. Claims 20-24, 28-37, and 41-45 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 20-24, 26-37, and 39-45, and 60 of U.S. Patent No. 6,329,488. Although the conflicting claims are not identical, they are not patentably distinct from each other because

For claims 20 and 33, the only difference between these claims and claims 20 and 33 of the '488 patent is that component (c) is not optional in the patent claims. It would have been obvious to one of ordinary skill in the art at the time of the invention to add component (c), an alcohol to components (a) and (b). The motivation would have been that it is suggested in the claim that the addition of alcohol would stabilize the

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copolymer, and therefore one of ordinary skill in the art desiring a stable copolymer, would have added an alcohol to provide an optional mixture.

Claims 21-24, 28-32, 34-37, and 41-45, of the instant application are identical to claims 21-24, 28-32, 34-37, and 41-45 of the '488 patent, respectively.

Claim Rejections - 35 USC § 112

5. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

6. Claims 9-13, 19, 25-27, 38-40, 47, 53-55, 57, and 58 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

For claim 9, the "polyol is a diol" lacks proper antecedent basis. The expression is not found in claim 5.

Claims 12, 19, 26, 39, 47, 54, and 58 contain the trademark/trade name "Carbowax 1450" and "Carbowax 8000". Where a trademark or trade name is used in a claim as a limitation to identify or describe a particular material or product, the claim does not comply with the requirements of 35 U.S.C. 112, second paragraph. See *Ex parte Simpson*, 218 USPQ 1020 (Bd. App. 1982). The claim scope is uncertain since the trademark or trade name cannot be used properly to identify any particular material or product. A trademark or trade name is used to identify a source of goods, and not the goods themselves. Thus, a trademark or trade name does not identify or describe the goods associated with the trademark or trade name. In the present case, the

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trademark/trade name is used to identify/describe polyethylene glycols of different molecular weights and, accordingly, the identification/description is indefinite.

For claims 11, 13, 25, 27, 38, 40, 53, 55, and 57 are indefinite because the expression "low molecular weight" and "higher molecular weight" are un-based comparatives whose meanings are uncertain. The expression lacks comparative values (low compared to what? High compared to what?).

Claim Rejections - 35 USC § 102

7. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

8. Claims 1-3, 48, and 52 are rejected under 35 U.S.C. 102(e) as being anticipated by Pinchuk (U.S. Patent No. 5,736,251).

For claims 1, 2, and 48, in column 2, line 62 through column 3, line 31, Pinchuk teaches a lubricious surface modification of a lubricious silane copolymer. In Example 1, column 9, lines 25-61, the silane copolymer is prepared from the methyltriacetoxysilane and ethyltriacetoxysilane monomers covering a silicone hemostasis valve. For claim 3, in column 10, line 40, Pinchuk also teaches that the article to be treated is a silicone catheter. For claim 52, in column 7, lines 27-41, Pinchuk teaches a primer coat and a topcoat.

Allowable Subject Matter

9. Claims 4, 49-51, and 56 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

10. Claims 9-13, 25-27, 38-40, 53-55, 57, and 58 would be allowable if rewritten to overcome the rejection(s) under 35 U.S.C. 112, second paragraph, set forth in this Office action and to include all of the limitations of the base claim and any intervening claims. Pinchuk does not teach the use of isocyanate-reactive silanes or a copolymer of a silane, polyol, and an isocyanate.

Conclusion

11. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Gaa et al. (U.S. Patent No. 4,582,873), Pohl et al. (U.S. Patent No. 4,645,816), Goldberg et al. (U.S. Patent No. 5,290,548), Roesler et al. (U.S. Patent No. 6,046,270), Yamazaki et al. (U.S. Patent No. 6,384,171), and Kunzler et al. (U.S. Patent No. 6,428,839) are cited as relevant to applicant's disclosure.


Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jeffrey B. Robertson whose telephone number is (703) 306-5929. The examiner can normally be reached on Mon-Fri 7:00-3:00.

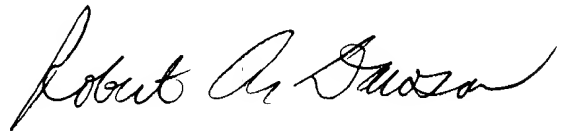
If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Robert A. Dawson can be reached on (703) 308-2340. The fax phone numbers for the organization where this application or proceeding is assigned are (703)

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872-9310 for regular communications and (703) 872-9311 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0661.

JBR 
January 10, 2003



Robert Dawson
Supervisory Patent Examiner
Technology Center 1700